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AUG 26 2009

OFFICE OF PETITIONS

AGENSYS C/O MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of :
Challita-Eid et al. :
Application No. 10/087,190 : ON APPLICATION FOR
Filed: February 28, 2002 : PATENT TERM ADJUSTMENT
Atty Docket No. 511582003420 :
Title: NUCLEIC ACID AND :
CORRESPONDING PROTEIN :
ENTITLED 121P1F1 USEFUL IN :
TREATMENT AND DETECTION OF :
CANCER :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705," filed May 6, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is one hundred and fifty-eight (158) days, not one hundred and fourteen (114) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction partly on the basis that the Office will take in excess of three years to issue this patent.

In addition, applicants assert that a two-day reduction for applicant delay was made in error.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for

continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that Applicants otherwise request review of the patent term adjustment, the request is **DISMISSED**.

On February 11, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 114 days. The instant application for patent term adjustment was timely filed² on or before payment of the issue fee.

Applicant disputes a reduction of two days, on the basis that the amendment that placed the application in allowance was allegedly expressly requested by the Examiner.³

Applicant's argument has been considered, and it is not deemed to be persuasive

A final Office action was mailed on October 24, 2008, and an after-final amendment was received on December 23, 2008. The amendment failed to place the application in condition for allowance, and consequently, an advisory action was mailed on January 16, 2009. An amendment in compliance with 37 C.F.R. § 1.113(c) was not filed until January 26, 2009, which is three months and 2 days after the mailing of the final Office action. This resulted in a reduction of two days.

The period of applicant delay in taking action in response to a final Office action is calculated based on the date a reply is filed in compliance with 37 CFR 1.113(c). MPEP 2731 sets forth, *in pertinent part*:

37 CFR 1.703(a)(3) also pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(ii) and specifies that the period is the number of days, if any, beginning on the day after the date that is four

² PALM records indicate that the issue fee was paid on May 6, 2009.

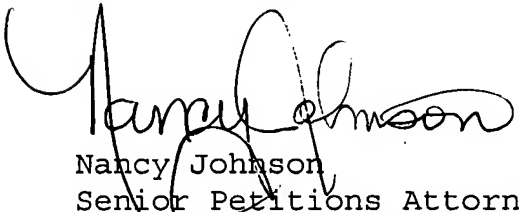
³ Petition, page 3.

months after the date a reply in compliance with 37 CFR 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. A reply under 37 CFR 1.113 is a reply to a final Office action, and a reply in compliance with 37 CFR 1.113 is a reply that cancels all of the rejected claims and removes all outstanding objections and requirements or otherwise places the application in condition for allowance. Any amendment after final that does not cancel all of the rejected claims and remove all outstanding objections and requirements or otherwise place the application in condition for allowance is not a reply in compliance with 37 CFR 1.113(c).

As such, the four-month period for the Office to provide a response does not commence until an acceptable reply to the final Office action is received. Therefore, the after-final amendment of December 23, 2008 that did not place the application in condition for allowance was not a proper reply. It follows that Applicant's delay continued to run pursuant to Rule 1.704(b) until a proper reply was received (January 26, 2009), when the Office's four-month period for response commenced.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name and title.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions